

REMARKS

In response to the Official Action mailed October 18, 2006, Applicants amend their application and request reconsideration. Claims 1, 4-9, 12-17, and 20-27 stand rejected. In this Amendment, claims 4, 12, and 20 are amended, and no claims are added or canceled. Claims 1, 4-9, 12-17, and 20-27 remain at issue.

I. 35 U.S.C §112 Obviousness Rejection of Claims

Claims 4, 12, and 20 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants respectfully submit that this rejection is moot in view of the present Amendment.

II. 35 U.S.C §103(a) Obviousness Rejection of Claims

Claims 1, 4-9, 12-17, and 20-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Rybicki et al.* (U.S. Patent No. 5,630,081, hereinafter “*Rybicki*”) in view of *Kucala* (U.S. Patent No. 5,832,489). Applicants respectfully traverse this rejection and respectfully request reconsideration.

To establish a *prima facie* case of obviousness, the cited references must teach or suggest all the claim limitations. MPEP §2143. The rejection of claim 1 under §103(a) is improper as the combination of *Rybicki* and *Kucala* does not teach or suggest all of the claim limitations. For example, the combination fails to teach or suggest “determining whether change tracking software on said disconnected device is compatible with change tracking software on said computer; and if the change tracking software on said disconnected device is not compatible with

the change tracking software on said computer, utilizing a data translation operation to convert tracked changes to a protocol useable by said computer.”

The Examiner concedes that *Rybicki* does not teach the above limitation, but contends *Kucala* teaches the limitation at column 5, lines 39-51. That passage merely states:

The embodiment of the present invention as described above assumes that the palmtop files and the PC files have records with identical field order and field names. However, this is not necessary to practice the synchronization method of the present invention. In cases where file formats are non-identical, prior art methods exist to perform translations or conversions of file formats, thus allowing the present invention to function after the non-identical file formats are in a format where records can be compared. This flexibility in file formats is an important feature of the present invention because it allows information to be synchronized between palmtop and PC applications that use different file systems and file formats.

In the previous Amendment After Final, Applicants respectfully noted that this passage says nothing of “change tracking software.” Nor does the passage say anything about determining change tracking software compatibility. Moreover, the passage says nothing of “a data translation operation to convert tracked changes” where the change tracking software is not compatible. In contravention to Examiner’s assertions, Applicants respectfully submitted that the conversion between file formats in *Kucala* is not suggestive of or equivalent to “determining whether change tracking software on said disconnected device is compatible with change tracking software on said computer,” nor is it suggestive of or equivalent to “utilizing a data translation operation to convert tracked changes to a protocol useable by said computer.” See, e.g., page 13, line 9 to page 14, line 13 of the patent specification. Applicants argued that change tracking software of differing protocols is not discussed in *Kucala*.

In response to Applicants arguments, the Examiner argues that

“Kucala discloses comparing the palmtop files and the PC files to see if they are identical in file formats and do translation if they are not identical (col. 5, lines 39-51). That means the change tracking software on the palmtop and the PC is [sic] not compatible, which cause a same file in two different devices look [sic] in different format.”

Applicants respectfully submit that the Examiner’s logic in that assertion is demonstrably false. The mere fact that the two files are in different formats says nothing of change tracking software compatibility, especially where the reference is not discussing change tracking software. There are innumerable reasons why two files might be in different formats. Because *Kucala* does explicitly teach or suggest “determining whether change tracking software on said disconnected device is compatible with change tracking software on said computer,” the Examiner is relying on what appears to be an inherency argument. However, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). The Examiner has failed to establish that, merely because *Kucala* discloses that two files on a PC and a palmtop are of a different format, a determination of whether **change tracking software** on the PC and the palmtop are compatible is **necessarily** performed.

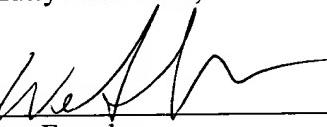
Accordingly, the combination of *Rybicki* and *Kucala* does not teach or suggest all of the claim limitations. Thus, *prima facie* obviousness has not been established, and the rejection should be withdrawn.

Claims 9 and 17 recite limitations similar to claim 1, and are thus patentable for at least the same reasons as given for claim 1. Claims 4-8, 12-16, and 20-27 depend from claims 1, 9, and 17, respectively, and are therefore patentable for at least the same reasons as given for claims 1, 9, and 17.

CONCLUSION

In view of the above amendments and remarks, Applicant submits that all claims are allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

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